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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,411	12/15/2003	James W. Nicholson	P1682 US (2650/191)	3962

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EXAMINER

NGUYEN, TUAN VAN

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 06/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.		Applicant(s)	
	10/736,411		NICHOLSON ET AL.	
	Examiner		Art Unit	
	Tuan V. Nguyen		3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on March 27, 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-17,19 and 20 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-17,19 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some * c) ☐ None of:
 - 1. ☐ Certified copies of the priority documents have been received.
 - 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| <ul style="list-style-type: none"> 1) <input type="checkbox"/> Notice of References Cited (PTO-892) 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____. | <ul style="list-style-type: none"> 4) <input type="checkbox"/> Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____. 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) 6) <input type="checkbox"/> Other: _____. |
|---|--|

DETAILED ACTION

1. Claims 1-20 were examined and rejected in previous Office Action.

Amendment After Non-Final Rejection

2. According to the Amendment After Non-Final Rejection applicants filed on March 23, 2006, applicants cancelled claims 2 and 18. Now, claims 1, 3-17, and 19 are pending in this present application.

Response to Amendment

3. Applicant's arguments filed on March 23, 2006 with respect to claims 1, 16 and 20 have been fully considered but they are moot in view of the new grounds of rejection.

Claim Rejections - 35 USC § 102

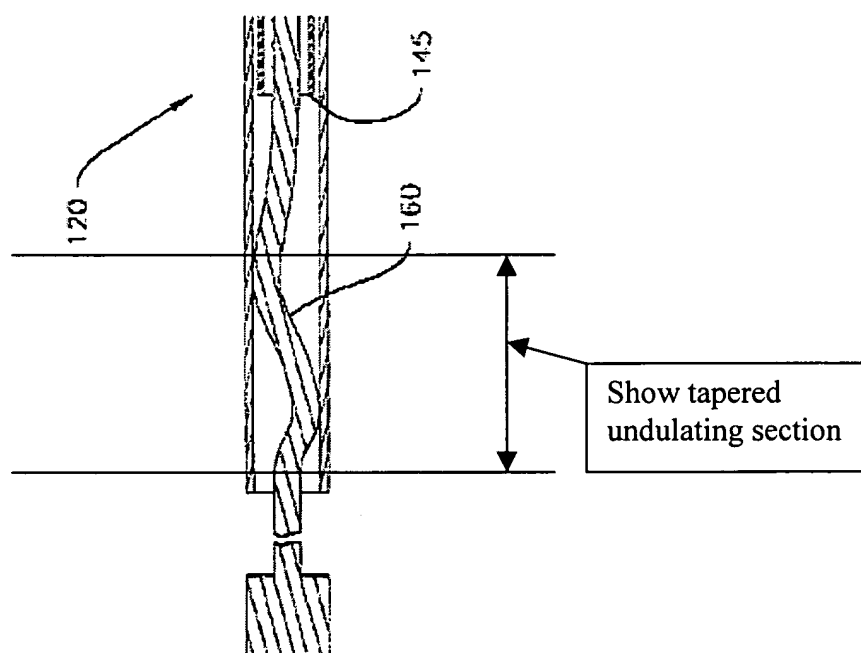
4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claims 1, 3-17, and 20 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Douk et al (U.S. 6,911,036).**
6. Referring to **claim 1**, Douk et al disclose a system for treating a vascular condition (see Figs. 4 and 5), the system comprising: a hollow Guidewire 144; a core wire 142 inserted through the hollow guidewire, the core wire including a tapered undulating section 160 (see an exact copy of Fig. 13 attached below this paragraph that further clarify the tapered undulating section) carried within the hollow guidewire; and an embolic filter device 25 or occluder device 320 (see Fig.13 and col. 8, lines 54-55) coupled between a distal end 27 of the hollow guidewire and a distal end 48 of the core wire, wherein the undulating section 160 of the core wire provides frictional control of the embolic containment device based on a direction of axial translation within the hollow guidewire. The undulating section 160 is frictionally contacted an inner surface of the hollow guidewire (see col 4, line 11 to col 5, line 53). With respect to the limitation “wherein the tapered undulating section provides a different amount of friction when the core wire translates in the first direction than when the core wire translates in the second direction”. Douk does not explicitly disclose the response to the effect of the tapered design, however, Douk discloses the structure as claimed in applicant’s invention. It has been held that it is elementary that the mere recitation of a newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to distinguish over the prior art. Additionally, where

the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on. *Swinehart*, 169 USPQ 226 (CCPA 1971).



7. Referring to **claims 2-9, 11-14**, they are rejected for the same reasons as claim 1.
8. Referring to **claim 15**, Douk et al disclose the coating disposed on the core wire to reduce friction between the core wire and hollow guidewire (see col. 7, lines 10-15).
9. Referring to **claims 16, 17, and 19**, Douk et al disclose a method for treating a vascular condition (see Figs. 4 and 5) the method comprising: providing a core wire 142 inserted through a hollow guidewire 144, the core wire including a

tapered undulating section 160 carried within the hollow guidewire; providing an embolic containment device 25 coupled between a distal end 48 of the hollow guidewire and a distal end 27 of the core wire; axially translating the core wire in a first direction relative to the hollow guidewire; expanding the embolic containment device based on the axial translation in the first direction; and controlling the axial translation in the first direction based on frictional resistance between the undulating section and an internal surface of the hollow guidewire. The method further comprising: capturing embolic material when the embolic containment device is expanded. The method further comprising: axially translating the core wire 142 in a second direction relative to the hollow guidewire 144; contracting the embolic containment device 25 within the vessel based on the axial translation in the second direction; and controlling the axial translation in the second direction based on frictional resistance between the undulating section and the internal surface of the hollow guidewire (see col. 4, line 11 to col. 5, line 8 and col. 11, line 45 to col. 12, line 2).

10. Still referring to **claim 16**, With respect to the limitation “wherein the tapered undulating section provides a different amount of friction when the core wire translates in the first direction than when the core wire translates in the second direction”. Douk does not explicitly disclose the effect of the tapered design, however, Douk discloses the structure as claimed in applicant’s invention. It has been held that it is elementary that the mere recitation of a newly discovered function or property, inherently possessed by things in the prior art, does not

cause a claim drawn to distinguish over the prior art. Additionally, where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on. Swinehart, 169 USPQ 226 (CCPA 1971).

11. **Claim 20 is rejected under 35 U.S.C. 102(e) as being anticipated by Douk et al (U.S. 6,911,036).**
12. Referring to **claim 20**, Douk et al disclose a system for treating a vascular condition (see Figs. 4 and 5), the system comprising: a hollow Guidewire 144; a core wire 142 inserted through the hollow guidewire, the core wire including an undulating section 160 carried within the hollow guidewire for providing frictional control of the expansion and contraction of an embolic containment device 25 or occluder device based on a direction of axial translation within the hollow guidewire. The tapered undulating section 160 is frictionally contacted an inner surface of the hollow guidewire (see col. 4, line 11 to col. 5, line 8). Douk further discloses an embolic filter device 25 or occluder device 320 (see Fig.13 and col. 8, lines 54-55) coupled between a distal end 27 of the hollow guidewire and a distal end 48 of the core wire. With respect to the limitation "providing a different amount of friction based on a translational direction of the core wire within the hollow guidewire". Here it is noted that Douk discloses a core wire having frictional control

means disposed within the hollow guidewire. Douk also discloses that different amount of friction can be achieved by selecting the amplitude, or maximal transverse dimension of bends 160 is selected (see col. 5, lines 45-50).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

15. **Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Douk et al (U.S. 6,911,036) further in view of Dubrul (Pub. No. U.S. 2004/0236369 A1, this application claims the benefit of Provisional application No. 60/083,178, filed on April 27, 1998. Provisional application No. 60/095,106, filed on August 3, 1998. Provisional application No. 60/115,548, filed on January 12, 1999).**

16. Referring to **claim 10**, Douk et al disclose the invention substantially as claimed except for the filter includes a braided wire mesh, and wherein at least a portion of the braided wire mesh is coated with elastomeric material. Dubrul discloses the embolic filter includes a braided wire mesh, and wherein at least a portion of the braided wire mesh is coated with elastomeric material (see paragraph [0057] and [0063]). It would have been obvious to one of ordinary skill in the art at the time the invention was made by the applicant to use the filter, as disclosed by Dubrul, to incorporate into the device, as disclosed by Douk et al because this will reduce the friction between the filament as suggested by Dubrul.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 6,270,513 to Tsugita et al.

U.S. Patent No.5,497,782 to Fugoso.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any


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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan V. Nguyen whose telephone number is 571-272-5962. The examiner can normally be reached on M-F: 9:00 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, AnhTuan Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tuan V. Nguyen
June 6, 2006


ANHTUAN T. NGUYEN
SUPERVISORY PATENT EXAMINER
6/12/06